

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Privacy Service Provided by Withheld for Privacy ehf / Xinke Liu
Case No. D2022-0018

1. The Parties

The Complainant is Philip Morris Products S.A., Switzerland, represented by D.M. Kisch Inc., South Africa.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Xinke Liu, Australia.

2. The Domain Names and Registrar

The disputed domain names <heatspost.com> and <heetsmail.com> (“the Domain Names”) are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 4, 2022. On January 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On January 4, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on January 5, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on January 6, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 31, 2022.

The Center appointed Dawn Osborne as the sole panelist in this matter on February 9, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is part of the Philip Morris group of companies famous for tobacco products across the world.

The Complainant is the owner, *inter alia*, of the following trademarks for smoking products:

- the word mark IQOS No. 5727311, registered in Japan on December 19, 2014;
- the word mark HEETS registered as International registration No. 1326410 on July 19, 2016; and
- a bird logo registered as International Registration No. 1331054 on October 11, 2016.

The Domain Name <heatspost.com> was registered on November 17, 2021. The Domain Name <heetsmail.com> was registered on November 27, 2021. The Domain Names have both been used in connection with very similar web sites selling e-cigarette products which use the Complainant's IQOS mark in their masthead and uses its bird logo mark within their tab interface. The Complainant's images of its products are reproduced on these web sites without permission and (whilst it may not be seen by Internet users) there is a copyright notice on the web sites claiming copyright in each respective contents.

The sites bear the following disclaimer: "All product and company names are trademarks™ or registered® trademarks of their respective holders. Use of them does not imply any affiliation with or endorsement by them. We are reseller of these products. 'IQOS', 'Marlboro', and 'Heatsticks' are registered trademarks of PMI (Phillip Morris International Inc.) in the United States and/or other countries. heatsshop is not endorsed nor affiliated with PMI (Phillip Morris International Inc.)".

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarised as follows:

The Complainant is the owner of the marks IQOS and HEETS and its bird logo registered as summarised above.

The Domain Names registered in November 2021 are confusingly similar to the Complainant's HEETS trade mark. The Domain Name <heetsmail.com> incorporates the Complainant's HEETS mark in its entirety adding only the dictionary word "mail" and the generic Top-Level Domain ("gTLD") ".com" which do not prevent confusing similarity. The Domain Name <heatspost.com> comprises a misspelling of the Complainant's mark using the letter "a" instead of one letter "e" and adding only the dictionary word "post" and the gTLD ".com" which do not prevent confusing similarity. In this context, as the Domain Name <heatspost.com> is used for a web site that features the Complainant's registered trade marks, it is reasonable to conclude that the Respondent registered the Domain Name <heatspost.com> precisely because it believed that it was confusingly similar to the Complainant's HEETS trade mark.

The Respondent does not have any rights or legitimate interests in the Domain Names, is not commonly known by them and is not authorised by the Complainant.

The Domain Names have been used for very similar web sites using the Complainant's IQOS mark in their mastheads, the Complainant's bird logo in their tab interfaces and images belonging to the Complainant of the Complainant's products without permission while claiming copyright in them in a false copyright notice. The sites are being presented as official sites of the Complainant.

The disclaimer at the bottom of the web sites will not be noticed by purchasers. In any event the information included in the disclaimer on the web sites attached to the Domain Names (recorded in full above) is ambiguous and inaccurate. It does not correctly identify the owners of the IQOS and HEATSTICKS trademarks, which are owned by the Complainant, as well as the MARLBORO trademark which is owned by Philip Morris Brands Sàrl outside of the United States of America, and by Philip Morris USA Inc in the United States of America. The disclaimer makes no mention of the HEETS trademark and the Complainant as owner of it. Nor does it properly disclose that the operator of the sites is not affiliated with the Complainant as the owner of the HEETS mark. Therefore, the information provided in the disclaimer is not sufficient to clarify the relationship between the web sites and the Complainant as relevant trade mark owner. As such this is not a *bona fide* offering of goods or services.

The use made by the Respondent of the Domain Names is registration and use in bad faith misleading Internet users for commercial gain and shows the Respondent is aware of the Complainant's trade marks, its business and products.

The Respondent or the person behind the Respondent indicated in the Whois Information, is the same person, or is connected to the same person, who was the respondent to a previous UDRP complaint where the domain names <heatsshop.com>, <iqosale.com>, and <iqosales.com> were attached to virtually identical sites to the site attached to the Domain Names showing a pattern of competing activity.

The use by the Respondent of a privacy service to hide its identity is also suggestive of bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Domain Name <heetsmail.com> consists of the Complainant's HEETS mark (which is registered, *inter alia*, as an international trade mark since 2016), the dictionary word "mail" and the gTLD ".com".

The Domain Name <heatspost.com> consists of a misspelling of the Complainant's HEETS mark, the dictionary word "post" and the gTLD ".com".

Previous UDRP panels have found confusing similarity when a respondent merely adds a dictionary word and a gTLD to a complainant's mark. The addition of the dictionary words "mail" or "post" and the gTLD ".com" does not prevent a finding of confusing similarity between each of the Domain Names and the Complainant's mark. Nor does the misspelling of the Complainant's mark in Domain Name <heatspost.com> replacing one letter "e" with a letter "a" prevent a finding of confusing similarity between that Domain Name and the Complainant's HEETS mark under the Policy.

Accordingly, the Panel holds that the Domain Names are confusingly similar to the Complainant's HEETS registered mark.

As such the Panel holds that paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The Complainant has not authorised the use of its marks. There is no evidence or reason to suggest that the Respondent (named as Xinke Liu in the domain name register details) is commonly known by the Domain Names. The use of the Domain Names is commercial and so is not legitimate noncommercial or fair use.

The web sites attached to the Domain Names uses the Complainant's IQOS mark in their mastheads, the Complainant's bird logo mark in their tab interfaces and images belonging to the Complainant to offer the Complainant's e-cigarette goods. The copyright notice on the web sites, whilst it may not be seen by Internet users, if seen, also falsely suggests the Respondent is the owner of the copyright in those images. The disclaimer on the web sites (recorded in full above) appears at the bottom of web pages and may easily not be seen by Internet users. In any event it contains inaccurate information and does not make the Respondent's identity clear. Noting the use of the Domain Names, and in particular the use of the Complainant's logo in the web sites at the Domain Names, the Panel finds that the Respondent tried to take advantage of the risk of implied association with the Complainant and its marks. The Panel finds this use of the Domain Names is confusing, and that the disclaimer does not erase such likelihood of confusion. As such it cannot amount to a *bona fide* offering of goods and services.

The Respondent has not answered this Complaint or presented any information to challenge the *prima facie* case made out by the Complainant that the use of the Domain Names is not legitimate.

As such the Panel finds that the Respondent does not have rights or legitimate interests in the Domain Names and that the Complainant has satisfied the second limb of the Policy.

C. Registered and Used in Bad Faith

In the opinion of the Panel the use made of the Domain Names in relation to the Respondent's web sites is confusing and disruptive in that visitors to the web sites might reasonably believe they are connected to or approved by the Complainant as they offer e-cigarette products under the Complainant's IQOS mark as a masthead, use the Complainant's bird logo in their tab interfaces and use the Complainant's images without permission (also falsely claiming copyright in them) giving the overall impression to Internet users that the web sites attached to the Domain Names have a connection with the Complainant as true owner of these rights. The inaccurate disclaimer on the sites may not be seen by Internet users and, in any event, is not sufficient to avoid relevant confusion. The reference to actual products of the Complainant and the use of its marks on the web sites also shows that the Respondent has actual knowledge of the Complainant's business, products and rights.

Accordingly, the Panel holds that the Respondent has intentionally attempted to attract for commercial gain Internet users to its web sites by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the web sites, also likely to disrupt the business of the Complainant.

Additionally, the Respondent has been the subject of another adverse decision under the UDRP (*Philip Morris Products S.A. v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Liu Xinke / IQOSPOST/Japan Tokyo Trading Pty Limited*, WIPO Case No. [D2021-2767](#)) in October 2021 for registering the domain names <heatsshop.com>, <iqosale.com>, and <iqosales.com> and using them for virtually identical sites to the Respondent's site attached to the Domain Names in this case. The Panel therefore holds there is evidence of a pattern of conduct and there is clear evidence that the Respondent had actual knowledge of the Complainant and its business, rights and products at time of registration of the Domain Names since the Respondent registered them in November 2021 one month after this previous UDRP decision.

As such, the Panelist believes that the Complainant has made out its case that the Domain Names were registered and used in bad faith and has satisfied the third limb of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names <heatspost.com> and <heetsmail.com> be transferred to the Complainant.

/Dawn Osborne/

Dawn Osborne

Sole Panelist

Date: February 23, 2022